

## REMARKS

### Rejection of the claims under 37 CFR §102(b)

Claims 1-7, 9 and 11 are rejected under 35 U.S.C. §102(b), allegedly, as being anticipated by Kimura et al. (US 5,690,916; hereinafter the " '916 reference"). The rejection states:

Kimura discloses a foundation comprising 9.0% by weight of blue interference pigment and iron oxides, 11.0% by weight of titanium dioxide, and sericite, other non-interference inorganic pigment which examiner view are used to match skin tone and thus meet the "skin color" limitation. See Example 13; instant claims 1-7, 9 and 11. The claimed method of covering wrinkles of the skin as recited is inherently practiced by using the prior art composition, since wrinkles and lines are naturally present on the cosmetic users' skin.

This rejection is respectfully traversed. Notwithstanding the Examiner's comment about a "skin color" limitation, which is not present in the claims of the present specification, it is taught in the '916 reference that the compositions disclosed therein are provided for adjusting skin color so that a hyperchromic portion of the skin can become inconspicuous by virtue of an interference action by a material in the compositions. It is disclosed that the reference compositions reflect a light component which is the same color as the discolored skin and transmit only a light component to the discolored skin which is a color complementary to the discoloration (interference effect). The discolored portion of the skin then reflects the light component of complementary color thereby tricking the viewer's eye into perceiving the discoloration as skin-colored. For example, as disclosed in the patent at col. 2, line 58 – col. 3, line 37, with reference to Figs. 1A, 1B and 1C, when white incident light impinges upon blue interference pigment in the reference composition applied to skin, the interference pigment reflects a blue light component of the white light and transmits only a light component which is a complementary color (e.g., red light) to the blue hyperchromic portion of skin. The blue skin then reflects the red light and thus becomes inconspicuous or substantially indistinguishable from the surrounding normal skin. Although the reference fails to explicitly or implicitly teach using the compositions disclosed therein to visibly reduce the appearance of age-related wrinkles or lines, it is the Examiner's opinion that the claimed method is inherently practiced by using the prior art compositions.

It is well-settled that inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Oelrich and Divigard*, 212 USPQ 323 (CCPA 1981) (citing *In re Hansgird v. Kemmer*, 40 USPQ 665). It must also be recognized that, in order for a reference to anticipate by inherency, the subject matter being claimed must undeniably and irrefutably follow from the prior art disclosure. *Hughes Aircraft Co. v. United States*, 8 USPQ2d 1580 (Ct. C. 1988). A person of ordinary skill in the art reading the reference and the present specification would appreciate that the method in the reference and the claimed method are not directed to the same population of people in need of such treatments on their skin. A person of ordinary skill in the art reading the reference would immediately understand that the compositions were not said to reduce the appearance of lines and wrinkles associated with aging of the skin.

That the step of applying the '916 reference composition to discolored skin might possibly also involve the application of the composition to age-wrinkled skin also is not adequate to support a rejection based on anticipation by inherency. The court in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 US 45, 66 (1923) held that accidental occurrences of the claimed subject matter, not intended and not appreciated, do not constitute anticipation.

One simply cannot ignore that the '916 reference does not teach applying the compositions to skin exhibiting lines and wrinkles for the specific purpose of reducing the appearance of lines and wrinkles associated with aging of the skin. In this connection, the Examiner is directed to *Nicholas V. Perricone, M.D. v. Medicis Pharmaceutical Corporation*, 77 USPQ2d 1321 (Fed Cir 2005) wherein it was held that the previously known use of a fatty acid ester of ascorbic acid for topical application to skin did not anticipate a method of treating skin sunburn comprising topically applying to the skin sunburn a fatty acid ester of ascorbic acid. The Court stated, "The issue is not, as the dissent and district court imply, whether Pereira's lotion if applied to skin sunburn would inherently treat that damage, but whether Pereira discloses the application of its composition to skin sunburn. It does not....New uses of old products or processes are indeed patentable subject matter. See 35 U.S.C. §101."

Present claim 1 has been amended for clarity and now recites the method as “applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment”. The Examiner cannot dismiss the explicit language of claim 1 “applying to the skin exhibiting the age-associated lines and wrinkles”. Skin exhibiting age-associated lines and wrinkles is not analogous to skin surfaces generally. Age-wrinkled skin is a clearly distinctive skin condition which develops over time as a result of many factors. Therefore, analogous to the circumstances in *Perricone*, the previously known use of interference pigments in cosmetics generally, or the more specific use of blue interference pigment for camouflaging hyperpigmented skin as taught in the ‘916 reference, does not anticipate a method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.

The reference compositions clearly may be applied to the hyperpigmented skin of a child, or a person of any age, whose skin does not yet exhibit age-associated lines and wrinkles which are conspicuous to others. In the absence of any teaching in the ‘916 reference that the composition also should be applied to age-wrinkled skin, so that the natural result of the operation disclosed in the ‘916 reference would result in the claimed step of applying the composition to age-wrinkled skin, and in the absence of any showing of the Examiner by extrinsic evidence that all skin bears age-related wrinkles, any application of the reference composition to wrinkled skin is accidental and inadequate to support a conclusion of anticipation. For these reasons, the rejection of claims 1-7 and 9 and 11 should be withdrawn.

Claim 6 has been amended to include a range of the inorganic powder, based on the disclosure in the present specification at page 4, lines 28-29. New claim 12 represents a combination of claims 1 and 6. The new claim is patentable for the same reasons as are claims 1-7, 9 and 11.

Rejection of the claims under 37 CFR §103(a)

Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) allegedly as being unpatentable over Hineno (US Patent No. 6,207,174; hereinafter the “ ‘174 reference”) in view of the ‘916 reference. The rejection states:

Hineno teaches a composite powder composition comprising interference or a reflective pigment which is effective in covering wrinkle and improving skin color. See Examples 1 and 2; Tables 2 and 3. Example 6 discloses a foundation comprising sericite, iron oxides, and 9.32% by weight of composite powder. See instant claims 1-7.

While the exemplified formulations contain 5% of red interference pigments, blue interference pigments are also taught in the specification, col. 13-14, Production Example (4), and in col. 5, Table 1. See instant claim 10.

As discussed above, Kimura teaches a foundation comprising 9% blue interference pigment and iron oxides, 11.0% by weight of titanium dioxide, and sericite, other non-interference inorganic pigments which examiner views are used to match skin tone and thus meet the “skin color” limitation. See Example 13.

Given the teaching of Hineno that interference pigments used in cosmetics cover wrinkles on the skin, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the exemplified cosmetic formulations of Hineno by using blue interference in a foundation as motivated by Kimura because 1) Hineno also generally teaches blue interference pigments useful for the invention; and 2) Kimura illustrates an example of a foundation comprising blue interference pigments. The skilled artisan would have had a reasonable expectation of successfully enhancing wrinkles on the skin by applying a cosmetic composition comprising blue interference pigments.

This rejection, too, is respectfully traversed. The Examiner again mentions a “skin color” limitation which is not present in claims 1-7 and 9-11. The Examiner also contends that although the ‘916 reference does not specifically disclose the application of the composition containing blue or violet interference pigment and a metal oxide pigment to age-wrinkled skin, the ‘174 reference teaches the application of interference pigments in a cosmetic composition for covering wrinkles, such that it would have been obvious to one skilled in the art, in view of the disclosure in the ‘174 reference to use the composition of the ‘916 reference to cover wrinkles. Appellants once again traverse this rejection. The claims at issue are directed toward a specific use of a specific type of interference pigment and not to a general use of interference pigments in disguising flaws.

The Appellants do not disagree that the '174 reference as a whole teaches that composite powders having essentially an unlimited number of interference colors may be produced for use for a variety of purposes. As stated in the reference in column 6, lines 6-12:

"This interference color mainly depends on the refractive index of the core particle, the refractive index of the coating component and the film thickness of the coating component in the composite powder of the present invention as mentioned above. That is, the desired interference color can be obtained from the composite powder of the present invention by properly adjusting these factors determining the interference color."

Notwithstanding the Examiner's overbroad interpretation of the teaching in the '174 reference that any colorant may be used in the composite powder, for any purpose, there is nothing in the reference which would lead one skilled in the art to believe that any composition can be utilized for any purpose. One skilled in the art would appreciate that the reference as a whole more accurately teaches that, in formulating a composition, particular attention is to be paid to the type of compositions (e.g., makeup), and to the purpose for incorporating the composite powder into the makeup composition (e.g., to hide wrinkles). The reference simply does not teach expressly or implicitly that all interference pigments can be used to camouflage wrinkles. The only disclosure taught for wrinkle coverage is red interference color.

The 13 disclosed examples may be preferred embodiments of the overall invention, but from a fair reading of the entire disclosure of the '174 reference, one skilled in the art must conclude that the examples of cosmetic compositions for application to the facial skin and the lips using an interference pigment having a red reflectance for improving skin color and for covering wrinkles are not merely preferred embodiments. There is explicit disclosure of a wrinkle covering capability, and that disclosure is found in the examples. Only certain compositions disclosed in the reference are indicated as useful for camouflaging wrinkles and those are found in Examples 1 and 2, including Tables 2 and 3, in columns 14-16 of the reference. Those compositions use only composite powder (1), the particles of composite powder (1) having a light red interference color (first production example, column 13, lines 3-23 of the reference). There is absolutely nothing in the reference which would suggest that a composition comprising a composite powder having any reflectance property other than a

substantially red reflectance property would demonstrate any efficacy for hiding wrinkles. Therefore, the reference fails to teach that a composition comprising a composite powder having a blue reflectance property would have any wrinkle covering effect whatsoever. The only teaching relating to wrinkles coverage which one skilled in the art could take away from this reference is that the only color that has any utility for this purpose is red.

In fact, considering the reference as a whole, it is notable that of a total of 13 examples, 7 examples are directed to cosmetic compositions. Six of the 7 examples use a pigment having a red reflectance. None of the 7 examples teaches a composition including an interference pigment having a blue reflectance. Five of the 7 examples relating to cosmetic compositions are compositions intended for application to the facial skin and the lips (facial cream, loose powder, foundations and lip cream), and all 5 of these examples employ red interference composite powder (1) for the primary purpose of improving skin color (i.e., imparting a rosy tone to the skin). In all cases, an improvement in skin color was observed after application of the red interference powder-containing compositions to the skin. In Examples 1 and 2, it is also observed, as shown in Tables 2 and 3, respectively, that the compositions which improve skin color also demonstrate a further benefit: a wrinkle covering capability. The authors of the reference provided many examples of cosmetic compositions, and had ample opportunity to provide an example of a cosmetic composition for use on the facial skin, including a composition for covering wrinkles, using an interference color other than red. Although the Examiner points out that a composition incorporating a blue interference pigment is disclosed in the reference (i.e., Example 10) that composition is not a cosmetic composition of any sort, but an adhesive. That all of the examples provided for the purpose of improving skin color and/or camouflaging wrinkles use only a pigment exhibiting a red reflectance is strong evidence that the use of only red interference color in these compositions was intended, and that these examples do not represent mere preferred embodiments, as the Examiner contends, of cosmetic compositions useful for application to the facial skin and lips for improving skin color.

As the '174 reference teaches away from the claimed method, one skilled in the art would just not have been led to use pigments having blue (or green or yellow) reflectance to improve skin color, or to blur the appearance of wrinkles in the skin. The

present invention is therefore both surprising and unexpected in view of the teachings in either the '961 reference, the '174 reference or the combination.

The faulty reasoning of the Examiner, based on a misinterpretation of the '916 reference, further demonstrates the Examiner's impermissible use of hindsight reconstruction of the claimed invention. The '916 reference is completely silent about wrinkles. The '174 reference teaches, with respect to cosmetic compositions for application to the facial skin, that improved color tone may be imparted to the skin, and that wrinkles in the skin may be covered, by applying to the skin a composition comprising a composite powder including an interference pigment having a red reflectance. There is no connection of blue with wrinkles in either reference. One skilled in the art would simply not have been guided by the '174 reference to use the '916 reference compositions, containing a pigment having a blue reflectance property, for covering wrinkles.

The combination of the '916 and the '174 references could only result in the teaching that a cosmetic composition for camouflaging a hyperpigmented area of the skin, and having a red reflectance, according to the '916 reference, when applied to skin according to the method of the '174 reference, would also hide wrinkles when the hyperpigmented skin also includes wrinkles. The combined teaching of these references therefore does not result in the claimed method. The Examiner has not therefore established a *prima facie* case of obviousness, and the invention as defined in claims 1-7 and 9-11 is patentable over the references cited.

#### Rejection of claim 8 under 35 U.S.C. §103(a)

Claim 8 is rejected under 35 U.S.C. §103(a) as unpatentable over the '174 reference and the '916 reference as applied to claims 1-7 and 9-11 above, and further in view of Hurst ("Face Powders", Poucher's Perfumes, Cosmetics and Soaps, 1993; hereinafter "Hurst"). The rejection states:

Hineno and Kimura, discussed above, fail to teach bismuth oxychloride. Hurst teaches that bismuth oxychloride is the first synthetic pearlescent pigment and now developed to provide an improved photosensitivity. See p. 117, 2<sup>nd</sup> full par. The reference further suggests that it is possible to formulate compositions using pearlescent pigments to provide

“translucent luster, or frosted effect, to enhance the wearer’s natural complexion”. See p. 117, 5<sup>th</sup> par.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the method of the combined references by adding bismuth oxychloride to the cosmetic composition comprising blue interference pigments, as motivated by Hurst, because of an expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

This rejection, too, is respectfully traversed. Hurst teaches the use of bismuth oxychloride in cosmetic compositions to enhance the complexion by providing luster or frost. There is no teaching in the reference related to wrinkles or to any interference pigments.

Claim 8, which is appended to claim 1, requires the presence of bismuth oxychloride in the composition used in the method recited in claim 1. The Examiner contends that it would have been obvious to have modified the composition of the combined ‘916 and ‘174 references, as motivated by Hurst, to arrive at the invention of claim 8, because of the expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

The arguments presented above, with respect to the rejection of claims 1 to 7 and 9 to 11 in view of the ‘916 and the ‘174 references are applicable here. The ‘916 reference fails to teach or suggest a method of using the compositions disclosed therein to visibly reduce wrinkles or lines in the skin caused by aging. The ‘174 reference fails to teach the use of a composition comprising a blue or violet interference pigment to camouflage wrinkles or lines in the skin, and in fact, teaches only the use of a composition comprising an interference pigment exhibiting a red reflectance for wrinkle coverage. The Hurst reference fails to remedy the defects of the combined teachings of the ‘916 and ‘174 references.

The combination of the ‘916 and ‘174 references is inadequate to support the rejection of claim 8, since at least one primary element of claim 1, to which claim 8 is appended, is not anticipated by or made obvious from the references. Specifically, the ‘916 reference does not teach the step of applying to the skin exhibiting age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment. Furthermore,



the '174 reference only teaches wrinkle camouflage using a composition comprising a red interference pigment. Hurst merely adds the further teaching that bismuth oxychloride may be used in powders to provide luster to enhance the complexion. Hurst cannot cure the deficiencies in the combined teachings of the '916 and the '174 references.

However, claim 8 is patentable for a further reason. One skilled in the art would not have incorporated bismuth oxychloride to add luster as taught in Hurst into the composition of the '916 reference, since it is disclosed in the '916 reference, at for example, column 17, lines 19-25, column 20, lines 34-39, and column 22, lines 18-23, that, after the application to skin of the composition containing the titanium dioxide coated mica (the interference pigment) a conventional foundation was applied so that the gloss of the titanium oxide coated mica was tempered or modulated to result in a natural transparent appearance so as to yield a finish which was comparable to the normal portion of the skin. It is therefore clear from the '916 reference that the skin to which the compositions containing the interference pigment were applied appeared undesirably glossy or lustrous; that is, insufficiently natural-looking, without covering the compositions further with a conventional foundation. On the other hand, as disclosed in the present specification in the paragraph common to pages 4 and 5, a preferred embodiment of the present invention (as recited in present claim 6) calls for the application, to age-associated wrinkled skin, of a composition incorporating a non-matte, non-spherical inorganic powder in an amount in the range of about 2 to about 10 weight percent. Although the compositions useful in carrying out the invention as recited in claim 1 do produce the desired reduction in the appearance of fine lines and wrinkles, it is an "all-or-nothing" appearance: the viewer perceives the full benefit of the reflectance from the interference pigment when looking at the skin from the specular angle, or head-on; however, when the same skin is viewed at an incident angle, the reflectance from the interference layer is not visible, and only the pigment is seen. Thus, the transition between these two views is quite sharp, and therefore somewhat less than ideal. However, it has been unexpectedly discovered by the Applicants that the transition between viewing at specular and incident angles can be softened by the inclusion in the formula of an inorganic powder. The most preferred powders for this purpose are non-matte, non-spherical powders which confer some luster, but not an overt shine, so that there is still some reflectance, albeit muted, even when it is not coming directly from the

interference pigment. Therefore, the Applicants have surprisingly discovered that the use of these powders in an amount of about 2 to about 10 weight percent in combination with the interference pigment and metal oxide results in the desired appearance of wrinkle reduction when viewed from any angle. It is noted that Example 13 of the '916 reference, noted by the Examiner, contains substantially greater than 10 weight percent of inorganic powders (i.e. 58.8% talc and sericite) which would be considered to provide a less than translucent, unnatural appearance to the skin.

The mere disclosure of bismuth oxychloride in the Hurst reference when the primary elements of the claims have not been shown to be either anticipated or obvious cannot then itself render the claims obvious. Since claim 8 depends directly from claims shown above to be nonobvious in view of the cited references, dependent claim 8 must also be found to be nonobvious. See *In re Fine*, 50 USPQ 2d 1596 (Fed. Cir. 1988). As the combination of the '916 reference and the '174 reference with Hurst does not result in the claimed method, the Examiner has not made out a *prima facie* case of obviousness and the invention as recited in claim 8 is patentable over the references cited.

### **CONCLUSION**

In light of the arguments presented above, the anticipation rejection of claims 1-7, 9 and 11, based on the '916 reference, the obviousness rejection of claims 1 to 7 and 9 to 11, based on the '196 reference in view of the '174 reference, and the obviousness rejection of claim 8 in view of the aforementioned references in further combination with the Hurst reference, should be reversed as they are unfounded.

Regarding claims 1 to 7 and 9 to 11, the '916 reference fails to disclose the essential step of applying the reference compositions to skin exhibiting age-associated lines and wrinkles. Furthermore, one of ordinary skill in the art would not have looked to the '916 reference for guidance in preparing wrinkle-camouflaging compositions, since the reference is silent concerning wrinkles and is directed to adjusting the appearance of a hyperchromic portion of the skin by applying to the portion of the skin in need of color adjustment a composition containing an interference pigment having a reflected light component of complementary color to the color of the skin in need of color adjustment.

The application of the compositions of the '916 reference to age-associated wrinkled skin is not taught explicitly or implicitly by the reference.

Moreover, the Examiner has provided neither extrinsic evidence nor inferences which one skilled in the art would reasonably be expected to draw from the applied references to prove that applying the compositions of the '916 reference to discolored skin necessarily brings about the claimed effect. The disclosure in the '174 reference could only lead the skilled person to use a '916 composition with an interference pigment having a red reflectance property to cover wrinkles.

Turning to the obviousness rejection of claim 8, the Hurst reference does not provide any teaching to remedy the defects of the '916 and '174 references, since the Hurst reference is concerned only with adding luster to powders and is entirely silent on reducing the appearance of age-related wrinkles in the skin, and since the mere disclosure of bismuth oxychloride, when the primary elements of the claims have '916 and the '174 references, cannot then itself render the claims obvious. Moreover, the '916 reference teaches against the combination with Hurst, since it discloses that the compositions incorporating the interference pigment are undesirably glossy, and that the gloss needs to be toned down by coverage with a conventional foundation to result in a desirable natural look of the skin.

Accordingly, the Appellants respectfully request withdrawal of the rejections of claims 1-11, and the allowance of claims 1-12.

Respectfully submitted,

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